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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/467,551      | 12/10/1999  | LYNN Y. LIU          | AIMN-01-006         | 2530             |

7590 06/13/2003

DONALD J. PAGEL  
LAW OFFICE OF DONALD J. PAGEL  
586 N. FIRST STREET  
SUITE 207  
SAN JOSE,, CA 95112

[REDACTED] EXAMINER

NGUYEN, NGA B

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3628

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HN

|                              |                      |                     |  |
|------------------------------|----------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Applicant No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/467,551           | LIU ET AL.          |  |
| <b>Examiner</b>              | <b>Art Unit</b>      |                     |  |
| Nga B. Nguyen                | 3628                 |                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 April 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-9,11-13,16-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9,11-13,16-18 and 20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachments

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>14</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on April 4, 2003, which paper has been placed of record in the file.
2. Claims 1-9, 11-13, 16-18, and 20 are pending in this application.

#### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-9, 11-13, 16-18, and 20 have been considered but are not persuasive.

In the argument, applicant stated that Network World I and Network World II do not teach a method as claimed in claim 1. Examiner respectfully disagrees. Note that the feature "using a first server to track an amount of time a first user is connected to the Internet through a first system operated by a first Internet Service Provider with whom the user does not have an account that allows the first Internet Service Provider to bill the user directly for the amount of time the user was connected to the Internet through the first system" described in claim 1 is the feature that provides roaming service to Internet users. Roaming service is well known in the mobile phone system in which as the mobile user moves out of the home area and into to a foreign area, telecommunications service is provided by a foreign wireless service provider typically not associated with the user's home wireless service provider. Operation in a foreign area is known as "roaming". Similarly, Network World I and Network World II teach that the UUNET Technologies Inc provides a roaming Internet access for international travelers. The user has account with UUNET, when the user travels in a foreign country,

the user can dial a local number to gain access to the Internet. It is obvious that the local number is generated by a local telephone company in the foreign country, whose the user does not have account with. Moreover, applicant stated that cannot use Hayes patent as combine reference with Network World I and Network World II because Hayes patent relates solely to a mobile phone system. Examiner respectfully disagrees.

Internet user gains access to the Internet by dial a telephone number, thus relates to telephone system. Moreover, Hayes teaches the method of accounting telephone roaming services, Network World I and Network World II also provides roaming services to the user. Therefore, combining Network World I and Network World II with Hayes is reasonable because those three references provides the roaming services in the telephone system. The same reason above applies for claims 6 and 12.

In conclusion, examiner decides to maintain the previous rejection (see details below) and make the action FINAL.

4. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-9, 11-13, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Network World Journal in view of Hayes, U.S. Patent No. 5,732,127.

Regarding to claims 1, 4, Network World discloses a method of accounting for services provided in an Internet access transaction comprising:

using a first server to track an amount of time a first user is connected to the Internet through a first system operated by a first Internet Service Provider with whom the user does not have an account that allows the first Internet Service Provider to bill the user directly for the amount of time the user was connected to the Internet through the first system (see the entire document).

Hayes discloses the accounting system for a roaming mobile station included transmitting a user record from the first server to a central settlement server; and using the central settlement server to generate a report from the user record (column 4, lines 42-60). Although, Hayes does not show user record comprising data that includes an identifier for the user and the amount of time the user was connected to the first system and the report including at least the amount of time the user was connected to the first system, it is obvious and well known to include the user identifier and the amount of

time the user was connected to the first system in Hayes's Call Detail Records and bill (report) in order to calculate the charge applied in every call made by the user. For example, the mobile telephone billing statement usually includes the amount of time and amount of charge based on the amount of time for every call the user made. Moreover, Hayes does not show the report being provided to a second Service Provider with whom the user does have an account and to the first Service Provider. However, it is obvious for the Hayes' s Administrative center to provide the report to first and second Service provider for future references.

Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to combine Hayes' s feature above with Network World's for the purpose of generating a report for the user in Internet roaming service.

Regarding to claims 2,3, Network World does not teach before generating the report, filtering the data in the user record includes the removal of duplicate records. However, filtering the data in the user record includes the removal of duplicate records is well-known in the art of data processing. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Network World's for the purpose of removing of duplicate records for generating a bill.

Regarding to claim 5, Network World does not disclose storing the user record on a second server before transmitting the user record to the central settlement server. However, storing or backup data on a second server is well-known in the art backup data. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Network World's for the security purpose.

Claims 6, 9, 18, 20 contain similar limitations found in claims 1-5, as discussed above, therefore, are rejected by the same rationale.

Regarding to claims 7-8, Network World does not disclose making the report available to the first Internet Service provider comprises publishing the roaming report on a World Wide Web server accessible by the first Internet Service Provider. However, assess the data published on the World Wide Web server is well-known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature above with Network World's for the purpose of providing more convenient for publisher/advertiser can view the billing information over the World Wide Web.

Regarding to claim 11, Network World does not disclose after the settlement report is made available to the second Internet Service Provider, transmitting funds from the second Internet Service Provider to a settlement operator and transmitting funds from the settlement operator to the first Internet Service Provider. However, transferring funds from second service provider to first service provider regarding to roaming service is well known in the art. Therefore, it would have been obvious to combine the feature above with Network World's for the purpose of allocating fund to first service provide whom the user made the roaming call.

Claims 12, 13, 16, 17 are written in means that parallel the limitations found in claims 6-9 discussed above, therefore are rejected by the same rationale.

### ***Conclusion***

7. Claims 1-9, 11-13, 16-18, and 20 are rejected.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nga B. Nguyen, whose telephone number is (703) 306-

2901. The examiner can normally be reached on Monday-Thursday from 8:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough, can be reached on (703) 308-0505.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

**9. Any response to this action should be mail to:**

Commissioner of Patents and Trademarks  
c/o Technology Center 3600  
Washington, D.C. 20231

**or faxed to:**

(703) 305-7687, (for formal communications intended for entry)

**or:**

(703) 308-3961 (for informal or draft communications, please  
label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Nga B. Nguyen  
June 10, 2003

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600